

REMARKS

In the Office Action mailed 6/28/2005, Claims 1-5, 7, 8, 12, 13, 14, 16 and 18 were rejected as being anticipated by the prior art under 35 U.S.C. §102(b). Claims 9-11, 15 and 17 were further rejected as being obvious over the prior art under 35 U.S.C. §103(a).

Disturbingly, Claims 1-18 were further rejected as failing to comply with the written description requirement by containing subject matter which was not described adequately in the specification as originally filed. Specifically, limitations of claims 1, 9 and 12 were indicated as being the focus of this rejection.

Finally, Claim 6 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite due to inaccurate language. As to this rejection, Applicant respectfully indicates that this claim is canceled. For the sake of clarity, Applicant has deleted the language of Claim 6.

In response, Applicant has submitted the proposed amendments to claims 1, 2, 3, 9 and 12 to further clarify the distinctions between the claimed invention and the prior art.

For the reasons set forth below, reconsideration of the rejections is requested and allowance of the present application is submitted to be in order.

New Matter Rejection

The Examiner has rejected claims 1-18 under 35 U.S.C. §112 as failing to comply with the written description requirement. He states that the claims (independent claims 1, 9 and 12 and the claims dependent thereon) were not described in the specification in such a

way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The general rule regarding breadth of the claims is that an applicant may draft claims as broad as the prior art permits so long as those claims are also supported by the disclosure.¹ As stated by the Board of Patent Appeals and Interferences, “[a]dequate description under the first paragraph of 35 U.S.C. 112 does not require *literal* support for the claimed invention . . . Rather, it is sufficient if the originally-filed disclosure would have conveyed to one having ordinary skill in the art that an appellant had possession of the concept of what is claimed.”² Furthermore, a drawing may be itself constitute a written description of the invention if it reasonably conveys to one of ordinary skill that the inventor possessed the invention.³

As to claim 1, the Examiner asks whether Applicant is referring to the arrangement of Figures 10A and 10B in which the elongated bar includes a top surface and a bottom surface. In Claim 1, Applicant is referring to the structure disclosed in Figures 10A and 10B and the accompanying text included at page 12, line 11 through page 13, line 8 to disclose this particular claimed embodiment. Other portions of the specification and accompanying drawings are also pertinent in order to fully disclose the claimed invention. Here, the elongate bar is clearly disclosed as “extending across the top surface of the head such that a void is formed between it and the projection surface.” The drawings and description, therefore, adequately convey to one of ordinary skill that the inventor possessed the invention at the time of the filing of the specification.

¹ *Orthokinetics Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1 USPQ 2d 1081 (Fed. Cir. 1986).

² *Ex parte Parks*, 30 USPQ 2d 1234 (B.P.A.I. 1994).

³ *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 19 USPQ 2d 1111 (Fed. Cir. 1991).

As to claim 9, these limitations, like claim 1, are disclosed by Figures 10A and 10B and the accompanying text, as well as the specification as a whole. The structure is clearly disclosed by depiction in the drawings and in the text (see page 13, lines 1-5) so as to convey that the claimed invention was in the inventor's possession at the time of filing of the original specification.

As to claim 12, the first and second faces are both clearly depicted in Figures 10A and 10B as being those faces perpendicular to the front face of the club head. The structure is therefore clearly disclosed by depiction in the drawings and in the text so as to convey that the claimed invention was in the inventor's possession at the time of filing of the original specification.

Since each of the claimed limitations (both amended and proposed amended) sufficient to convey that the invention was in the inventor's possession at the time of filing, Applicant respectfully asserts that this ground for rejection should be withdrawn.

Anticipation Rejection under 35 U.S.C. §102(b)

As a preliminary matter, Applicant respectfully asserts that his amendment did not necessitate the new grounds for rejection over Kaise, and therefore the finality of this ground for rejection should be withdrawn. While Kaise was listed as "having alignment features of interest," it was in no way specifically cited as a ground for rejection previous to the subject office action. As such, it is Applicant's respectful position that the instant rejections are the first based on this reference, and that Applicant's amendment simply sought to clarify the claimed invention from the relied-upon references; had the Examiner relied upon Kaise in his first action, this case would likely have been amended at that time. Since the Examiner

was the examiner of record in the Kaise application, clearly he was aware of its pertinence to the patentability of Applicant's disclosed invention, he should be bound by his failure to rely on that reference in his first action.

Kaise, U.S. Patent No 6,062,986

This reference is cited by the examiner as anticipating Claims 1-5, 7, 8, 12, 13, 14, 16 and 18. Applicant respectfully traverses this rejection as it applies to independent Claim 1, as proposed amended, since Kaise fails to disclose the following recited structure: "elongate bar" "interconnecting" a "front thick portion and . . . rear thick portion." Since these limitations are not recited by Kaise, each and every element of Applicant's claimed invention cannot be found in Kaise, and this ground for rejection must be withdrawn.

Similarly, Kaise fails to disclose "an elongate bar shape having a first face and a second face parallel to said first face," "a pair of opposing ends in perpendicular alignment to said head face," nor "opposing ends extending from a front thickened portion and a rear thickened portion, respectively." Since these limitations are not recited by Kaise, each and every element of Applicant's claimed invention cannot be found in Kaise, and this ground for rejection must be withdrawn.

Applicant also respectfully points out that Kaise, in failing to disclose the thickened portions and elongate bar portion is unworkable as compared to Applicant's claimed invention, since these structures add to the user's ability to align the club head with the ball and hole, improves the paralactic alignment of the golfer's head with the club by providing a longer alignment area, and also provides a club head that is more evenly weighted than is

Kaise. As such, Kaise also fails to suggest Applicant's claimed invention, and in fact teaches away from the claimed structure.

Obviousness Rejection under 35 U.S.C. §103(a)

Here, as discussed above, Applicant respectfully asserts that his amendment did not necessitate the new grounds for rejection over Hamilton, and therefore the finality of this ground for rejection should be withdrawn. While Hamilton was listed as "having alignment features of interest," it was in no way specifically cited as a ground for rejection previous to the subject office action. As such, it is Applicant's respectful position that the instant rejections are the first based on this reference, and that Applicant's amendment simply sought to clarify the claimed invention from the relied-upon references; had the Examiner relied upon Hamilton in his first action, this case would likely have been amended at that time.

Hamilton, U.S. Patent No. 4,343,472

Claims 9-11 and 17 are rejected as being obvious under 35 U.S.C. §103(a) over the combination of Hamilton and Kaise. Neither Hamilton nor Kaise disclose the claimed "elongate bar" having "a first club-head-attaching end attachable in proximity to said head front face and a second club-head-attaching end attachable in proximity to said head rear face." Hamilton, in contrast has a upwardly-turned triangular shape, and Kaise has an "upper face" of the club head that is only attached at its front (club face) side, and its rear end is free and is cantilevered over the bottom of the club head.

Nothing in either Hamilton nor Kaise suggest Applicant's claimed structure, either alone or in combination, and therefore the prima facie case of obviousness has not been made out, and this ground for rejection should be withdrawn.

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests that the application be reconsidered, the claims be allowed, and the case passed to issue. If any impediment to the allowance of the claims remains after consideration of this request for reconsideration, and such impediment could be alleviated during a telephone interview, the Examiner is invited to telephone the undersigned so that such issues may be resolved as expeditiously as possible.

Respectfully submitted,

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